REMARKS

Claims 1-37, 41-43, 45-49 and 53-55 are currently pending in the subject application and are presently under consideration. Favorable consideration of the subject patent application is respectfully requested in view of the comments herein.

I. Objection to Drawings

The amendments to the drawings filed April 26, 2004, are objected to because they introduce new matter. This objection should be withdrawn for at least the following reasons. In the Office Action dated December 17, 2003, the Examiner objected to the drawings under 37 C.F.R. §1.83(a), asserting that the drawings must show every feature of the invention specified in the claims. In particular, the Examiner, in reference to the rejection of claim 42 under 35 U.S.C. §112, second paragraph, contended it was not clear whether the Applicant intends to claim a feedback signal from the controller to the diagnostics module, and stated: "if Applicant intends to claim said feedback signal, the drawings should be amended to illustrate the signal or the feature(s) cancelled from the claims." *Id.* In response to the Examiner's objection, applicants' representative submitted a set of amended drawings, Figures 3-6, illustrating the feedback signal inherent in claim 42, and specifically indicated that should the Examiner deem the amendments to constitute new matter that the Examiner's attention was directed to MPEP §2163, which states: "the claims as filed are part of the disclosure ... the applicant may amend the specification to include the claimed subject matter. *In re Benno,* 768 F.2d 1340, 226 USPQ 683 (Fed. Cir 1985)".

In the instant Final Office Action dated July 13, 2004, the Examiner, in the Response to Arguments section, withdraws the objection to the drawings raised in the previous Office Action dated December 17, 2003, but nevertheless objects to the amended drawings as introducing new matter into the application. In particular, the Examiner contends that the feedback signal 73 of amended figures 3-6 constitutes new matter and must therefore be corrected. Applicants' representative avers to the contrary.

Claim 42, to which the amendments to the drawings were directed, recites in its original form: ***the control and diagnostics system according to claim 41, wherein said diagnostics module generates said health assessment signal based on said driving***

output, and in its amended form: ***the control and diagnostics system according to claim 41, wherein said diagnostics module generates said health assessment signal at least partially based on said driving output produced by said controller***. Further, independent claim 41, from which claim 42 depends recites: ***a diagnostics module to generate a health assessment signal indicative of the health of the motor; a controller coupled to the motor, said controller outputting a driving output based on said health assessment signal, wherein said driving output is applied to the motor***. It is apparent that when claim 42, irrespective of its form, original or amended, and independent claim 41 are read together that the invention as claimed relates to a diagnostics module that generates health assessment signals indicative of the health of the motor, and a controller that is coupled to the motor, wherein the controller outputs a driving output based on the health assessment signal generated by the diagnostics module to the motor. In addition, the health assessment signal from the diagnostics module is also based on the driving output that is produced by the controller. Thus, it would be clear to one skilled in the art that there exists an inherent feedback loop between the controller and the diagnostics module to effectuate the supply of the driving output from the controller to the diagnostics module so that the diagnostics module can generate a health assessment signal at least partially based upon the driving output supplied by the controller.

The Examiner is reminded that the abstract, specification, drawings and claims as filed comprise the disclosure of the application, and according to MPEP §2163.06: "information contained in ***any one*** of the specification, ***claims*** or drawings of the application as filed ***may be added to any other part*** of the application without introducing new matter." *Id.* (emphasis added). In addition, MPEP §2163.07(a) provides that by "disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter." *Id.* Further, the courts have consistently maintained that information that is well known in the art need not be described in detail in the specification. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379-80, 231 USPQ 81, 90 (Fed. Cir. 1986). It is

submitted that claim 42, both as originally filed and as it currently stands, provides sufficient basis to substantiate the amendments to the objected drawings, *viz.* Figures 3-6, on the grounds that the amendments to the drawings merely make clear that which is inherent in the disclosure.

It should also be noted in this context that page 5, lines 18-20, of the application as filed makes reference to the fact that "the output of the controller may be provided to the diagnostics system so that the health assessment made by the diagnostics system can be based at least in part on the control signal and the response by the motorized system to this control action." *Id.* Thus, contrary to the Examiner's assertion that new matter has been added, it is applicants' representatives' contention that not only do claims 41 and 42 as originally filed teach an inherent feedback loop between the controller and the diagnostics module, but that support for the inherency and amendment to the drawings can be found in the above cited passage of the application.

Accordingly, since claim 42 as originally filed inherently discloses a feedback loop, readily recognizable as such to one ordinarily skilled in the art, between the diagnostics module and the controller, and further in view of the amendments to the drawings to clarify the inherency, it is submitted that this objection should be withdrawn.

II. Objection to Specification Under 35 U.S.C. §132

The amendment to the specification filed April 26, 2004 is objected to under 35 U.S.C. §132 because it introduces new matter into the disclosure. This objection should be withdrawn for at least the following reason. As discussed in connection with the objection to the drawings above, since claim 42 as originally filed alone provides sufficient substantiation for the amendment to the specification, and the amendment made to the specification renders explicit that which is inherent in claim 42, this objection should be withdrawn. Additionally, as has also been elucidated above, with respect to the objection to the drawings, MPEP §2163.06 specifically provides that information contained in any one of the specification, claims or drawings of the application as filed can be added to any other part of the application without introducing new matter. Further, given that the Court of Appeal for the Federal Circuit has consistently held that information well-known in the art need not be described in detail in the specification; that

both, claim 42 and the specification, at page 5, lines 18-20, provide support for the inherency of the feedback loop between the diagnostics module and the controller; and that utilization of feedback loops are universally known in the art, applicants' representative submits that the objection to the amendment made to the specification in the Reply to Office Action dated December 17, 2003, does not introduce new matter into the disclosure. Accordingly, withdrawal of this objection is respectfully requested.

III. Rejection of Claims 42 and 54 Under 35 U.S.C. §112

Claims 42 and 54 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner contends that the subject claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, and specifically that the amendments made in the prior Reply to Office Action introduces new matter. This rejection should be withdrawn for at least the following reasons. In the Reply to Office Action dated December 17, 2003, dependent claim 42 was amended to recite: ***the control and diagnostics system according to claim 41, wherein said diagnostics module generates said health assessment signal at least partially based on said driving output produced by said controller***. Applicants' representative drew support for these amendments from claim 42 as originally filed, and MPEP §2163, wherein it states "the claims as filed are part of the disclosure ... the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985)". Applicants' representative still maintains, and reiterates, that claim 42 as originally filed provides sufficient support to substantiate the amendments made in the Reply to Office Action dated December 17, 2003, since the amendments made merely make explicit that which heretofore had been inherent within the language of dependent claim 42 as originally filed. Nevertheless, as has also been stated above in connection with both the objection to the drawings and the specification, the Examiner is directed to page 5, lines 18-20, which provides additional support for the amendments made to dependent claim 42. Accordingly, in view of at least the foregoing, it is requested that the rejection of claim 42, and claim 54 depending from claim 42, be

withdrawn.

IV. Rejection of Claims 1-7, 10-11, 15, 31-34, 36-37, 41-43, 45-47, 49 and 53-55 Under 35 U.S.C. §102(e)

Claims 1-7, 10-11, 15, 31-34, 36-37, 41-43, 45-47, 49 and 53-55 stand rejected under 35 U.S.C. §102(e) as being anticipated by Hays *et al.* (US 6,260,004 B1). It is respectfully requested that this rejection be withdrawn for at least the following reasons. Hays *et al.* fails to teach or suggest each and every limitation set forth in the subject claims.

> A single prior art reference anticipates a patent claim only if it expressly or inherently describes ***each and every limitation set forth in the patent claim***. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention ***must be shown in as complete detail as is contained in the ... claim***. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

The invention as claimed relates to a diagnostics and control system that controls a motorized system, the motorized system comprising disparate motorized devices. Independent claim 1 recites: ***a diagnostics and control system*** *for controlling a motorized system and diagnosing the health thereof, comprising: a controller operatively associated with the motorized system and adapted to operate the motorized system in a controlled fashion, and a diagnostics system operatively associated with the motorized system and adapted to diagnose the health of the motorized system according to a measured attribute associated with the motorized system, the diagnostics system providing a diagnostic signal to the controller.* Independent claim 32 narrates a method of utilizing the recited diagnostics and control system comprising: *operating a motor in the motorized system in a controlled fashion, diagnosing the health of the motorized system according to a measured attribute associated with the motorized system, and generating a diagnostics signal communicated to a controller.* Further, independent claim 41 recites: ***an integrated control and diagnostics system*** *for a motor, the system comprising: a*

diagnostics module to generate a health assessment signal indicative of the health of the motor, a controller coupled to the motor, said controller outputting a driving output based on said health assessment signal, wherein said driving output is applied to the motor. It is thus apparent that the claimed invention relates to an ***integrated*** diagnostics and controller system that forms a unitary whole. Hays *et al.* fails to teach or suggest this novel and exemplary aspect of the invention as claimed.

Hays *et al.* discloses an apparatus and method for diagnosing a pump system, wherein diagnostics are utilized to determine impending failures of the pump. Hays *et al.* however, is silent regarding an integrated diagnostics and controller system. In Hays *et al.* the diagnostics module and the controller are two separate entities and are not integrated to form a unitary whole as is apparent in the invention as claimed.

While applicants' representative is cognizant that in general claim preamble does not impart limitations on a claim, it is nevertheless asserted that "if the claim preamble ... is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). Since the preambles of both claims 1 and 41 are necessary to denote the fact that the invention as claimed pertains to ***an integrated diagnostics and control system***, the preambles give life, meaning and vitality to the claims and consequently should be construed as such in the balance of the claims. In addition, even though independent claim 32 does not explicitly recite ***a diagnostics and control system***, or ***an integrated diagnostics and control system*** in its preamble, the mere fact that claim 32 provides a method to effectuate the functioning of the ***diagnostics and control system*** recited in claims 1 and 41, and that "a claim term should be construed consistently ... in other claims in the same patent", *See Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851 (Fed. Cir. 2001), indicates that the method disclosed in independent claim 32 should be construed in light of the fact that the method elucidated therein, relates to ***an integrated diagnostics and control system***. Accordingly, withdrawal of this rejection is respectfully requested in relation to independent claims 1, 32 and 41 and associated dependent claims.

V. **Rejection of Claims 8-9, 12-14 and 16-19 Under 35 U.S.C. §103(a)**

Claims 8-9, 12-14 and 16-19 stand rejected under 35 U.S.C. §103(a) as being obvious over Hays *et al.* (US 6,260,004 B1) in view of Ogi *et al.* (US 5,419,197). Claims 8-9, 12-14 and 16-19 depend from independent claim 1, and as discussed *supra*, Hays *et al.* fails to teach or suggest all the limitations recited in independent claim 1, and Ogi *et al.* does not make up for the deficiencies inherent in Hays *et al.* Withdrawal of this rejection is therefore requested.

VI. **Rejection of Claims 20-30 and 35 Under 35 U.S.C. §103(a)**

Claims 20-30 and 35 stand rejected under 35 U.S.C. §103(a) as being obvious over Hays *et al.* (US 6,260,004 B1) in view of Petsche *et al.* (US 5,640,103). Withdrawal of this rejection is respectfully requested for at least the following reason. Claims 20-30 and 35 depend from independent claim 1, and Petsche *et al.* does not make up for the deficiencies presented by Hays *et al.* as state above. Accordingly, reversal of the rejection is requested.

VII. **Rejection of Claim 48 Under 35 U.S.C. §103(a)**

Claim 48 stands rejected under 35 U.S.C. §103(a) as being obvious over Hays *et al.* (US 6,260,004 B1) in view of Gotou *et al.* (US 4,933,834). Claim 48 depends from independent claim 41, and for the reasons stated above, Hays *et al.* does not teach or suggest all the limitations set forth in independent claim 41, and Gotou *et al.* fails to rectify these deficiencies. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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